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In re Application of :
ADORINI, Luciano, et al. : DECISION
U.S. Application No.: 10/553,854 :
PCT No.: PCT/US2004/013703 :
International Filing Date: 30 April 2004 :
Priority Date: 30 April 2003 :
Attorney's Docket No.: 59756DIV2(49949) :
For: USE OF GEMINI VITAMIN D3
COMPOUNDS FOR TREATING
HYPERTENSION :
:

This decision is issued in response to applicants' "Petition To Correct Inventorship Under 37 CFR 1.48 In Response To Notification Of Defective Response" filed 30 August 2007. Applicants have paid the required processing fee.

BACKGROUND

On 30 April 2006, applicants filed international application PCT/US2004/013703. The international application claimed a priority date of 30 April 2003, and it designated the United States. The deadline for filing the basic national fee was thirty months from the priority date, that is, 30 October 2005.

There are five inventors of record in the international application: Luciano ADORINI, Giuseppe PENNA, Milan R. USKOKOVIC, Hubert MAEHR, and Yan Chun LI.

On 19 October 2007, applicants filed a Transmittal Letter seeking entry into the U.S. national stage accompanied by, among other materials, payment of the basic national fee.

On 30 November 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required.

On 27 February 2007, applicants filed a declaration in response to the Notification Of Missing Requirements (with required extension fee). The declaration names, and is executed by, only two of the inventors of record, Milan R. USKOKOVIC and Yan Chun LI.

On 01 August 2007, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/DO/EO/916) indicating that the declaration filed 27 February 2007 was defective in

that inventors of record Luciano ADORINI, Giuseppe PENNA, and Hubert MAEHR had not signed the declaration, and because an inventor who was not listed on the published international application, Yan Chun LI, had signed the declaration.¹ The Form PCT/DO/EO/916 indicated that applicants were required to provide an oath or declaration in compliance with 37 CFR 1.497 within a non-extendable one month deadline, and that failure to do so would result in abandonment of the application.

On 30 August 2007, applicants filed the “Petition To Correct Inventorship Under 37 CFR 1.48 In Response To Notification Of Defective Response.” The petition seeks to remove Luciano ADORINI, Giuseppe PENNA, and Hubert MAEHR as inventors herein, thereby permitting acceptance of the previously filed declaration.

DISCUSSION

Applicants state in the present petition under 37 CFR 1.48(b) that the correct inventors were named in the international application but that, as a result of “the amendment or cancellation of claims” in the present national stage application, “fewer than all of the inventors named in the PCT application are the actual inventors of the invention being claimed in the national stage application.” The petition therefore requests deletion of the three inventors whose invention is no longer being claimed, pursuant to 37 CFR 1.48(b).

Correction of inventorship under 37 CFR 1.48(b) is only available in non-provisional applications. As set forth in 37 CFR 1.9(a)(3), a national stage application filed under 35 U.S.C. 371 is not considered a “non-provisional” application until “after compliance with 35 U.S.C. 371.” In the present case, applicants have failed to comply with 35 U.S.C. 371 (c)(4) in that an oath or declaration, in compliance with 35 CFR 1.497(a)-(b), executed by all five of the inventors of record, has not been submitted. Accordingly, the request under 37 CFR 1.48(b) is an improper response to the “Notification of Defective Response” mailed 01 August 2007.

Because the Notification of Defective Response mailed 01 August 2007 specifically identified the defect in the declaration filed 27 February 2007 (i.e., the lack of execution by inventors Luciano ADORINI, Giuseppe PENNA, and Hubert MAEHR), and applicants have not timely filed the proper reply to such Notification, the present application is hereby held to be ABANDONED.

CONCLUSION

For the reasons above, the present application is ABANDONED and the request under 37 CFR 1.48(b) is DISMISSED as premature.

Applicants may wish to consider filing a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137. This recommendation to file

¹ It is noted that Mr. LI was added to the international application after publication, pursuant to PCT Rule 92bis. Accordingly, Mr. LI is an inventor of record herein and his presence on the declaration is proper.

a petition under 37 CFR 1.137(a) or (b) should not be construed as an indication as to whether or not any such petition(s) will be favorably considered.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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